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| 09/771,880      | 01/30/2001  | Hiroshi Hagane       | Q62767              | 2676             |

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

LELE, TANMAY S

ART UNIT PAPER NUMBER

2684

DATE MAILED: 02/25/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/771,880

Applicant(s)

HAGANE, HIROSHI

Examiner

Tanmay S Lele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 08 December 2003 have been fully considered but they are not persuasive.
2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Regarding claims 1 – 18, Applicant attempts to overcome the rejection by stating, “Thus, absent Applicant's own disclosure, one skilled in the art would not have been motivated to combine, or would not have known how to combine, Chen and Toru to achieve Applicant's claimed invention.” Examiner respectfully disagrees with Applicant's assertion that the art cannot be combined for the cited motivation to yield the claimed as presented. Applicant as support for the assertion by further stating, “Thus, Chen teaches away from ‘packet communication’ in conjunction with searching based on voice recognition,” and further that, “In particular, the object of Chen's invention is to ‘audibly speak’ the results [of a search request] to the end user, thereby eliminating the need for any display at the telephone instruments.” Note that Chen states presentation by the gateway of the system can be determined based on how the request was made, and further provides provisions for a packet data system here (column 5, lines

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22 –35). Note additionally that Chen allows for the ability to display alphanumeric text if sent (column 5, lines 14 –16 and again in column 6, lines 36 –39). It is respectfully believed that both the above stated are contrary to Applicant's assertion that, Chen teaches of "...eliminating the need for any display at the telephone instruments..." and that Chen teaches "...away from packet communications..."

Applicant further attempts to overcome the rejection by stating, "Nowhere does Toru disclose, teach or suggest transmitting back to the mobile terminal user speech signals of a speech information obtained as a search result," and further that, "in fact, Toru does not even mention a possibility that its search result may include speech information, let alone disclose or suggest how such a result may be communicated back to the mobile terminal user." Note that as stated in the previous Office Action (paper number 7, pages 3 – 4), Chen was cited as performing these functions.

Applicant further states, "[()]Notably, an objective of Chen's invention is to eliminate the need for providing HTML links (see Chen col. 1, line 39 thorough col. 2, line 5)." Note that Toru includes provisions to display the information of the HTML link (paragraph 0032). Hence Examiner is not persuaded by Applicant's arguments that the cited art cannot be combined for the cited motivation to teach or recite the claims as currently presented.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (Chen, European Patent Application No. 859,500) in view of Toru (Toru, Japanese Patent Application No. 08-285,086).

Regarding claim 1, Chen teaches of an information search system (Figures 1 – 4) comprising: a terminal having a speech communication function and packet communication function (Figures 1 – 4 and column 2, lines 24 – 49); and a center for selectively performing speech communication and packet communication with said terminal (Figures 1 – 4 and column 2, lines 24 – 49), said center comprising speech control means for performing speech communication with said terminal during execution of packet communication by said terminal (Figures 1 – 4 and column 2, lines 24 – 49), information search means for searching for information on the basis of the speech information recognized by said speech recognition means (column 4, lines 44 – 51), speech conversion means for converting the speech information of the information searched out by said information search means into a speech signal and outputting the signal to said speech control means (Figures 1 – 4 and column 2, lines 24 – 49), the speech signal from said speech conversion means being transmitted to said terminal by said speech control means (Figures 1 – 4 and column 2, lines 24 – 49).

Chen does not specifically state speech recognition means for recognizing a speech signal received by said speech control means and sent from said terminal and packet control means for transmitting at least one of image information and character information of the information searched by said information search means to said terminal by packet communication (though it should be noted that Chen does teach of and packet control means for transmitting character

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information of the information searched by said information search means to said terminal by packet communication in column 3, lines 39 – 50).

In a related art dealing with searching Internet databases using a mobile device, Toru teaches of speech recognition means for recognizing a speech signal received by said speech control means and sent from said terminal (abstract and page 4, paragraph 0032 of the “Detailed Description” translation packet); and packet control means for transmitting at least one of image information and character information of the information searched by said information search means to said terminal by packet communication (abstract and page 4, paragraph 0032 of the “Detailed Description” translation packet and Drawings 1 and 20 – 23).

It would have been obvious to one skilled in the art at the time of invention to have included into Chen’s mobile inquiry system, Toru’s voice recognition system, for the purposes of speaking user commands to access information for viewing, as taught by Toru.

Regarding claim 2, Chen in view of Toru, teach all the claimed limitations as recited in claim 1. Both Chen and Toru teach of wherein said information search means searches for information through the Internet (Chen: Column 4, lines 52 – 57 and Figure 1; Toru: abstract and page 4, paragraph 0032 of the “Detailed Description” translation packet).

Regarding claims 3 and 14, Chen in view of Toru, teach all the claimed limitations as recited in claims 1 and 13. Chen further teaches of wherein said system further comprises a table indicating a relationship between a self-station packet communication address of said terminal and a self-station speech communication address (Figure 2 and column 4, lines 44 – 58), and said speech control means looks up said table when speech communication is started, and notifies said packet control means of a self-station packet communication address corresponding to the

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self-station speech communication address of said terminal which is notified by the calling number identification notifying function (Figure 2 and column 4, lines 44 – 58).

Regarding claims 4 and 15, Chen in view of Toru, teach all the claimed limitations as recited in claims 3 and 14. Chen further teaches of wherein the self-station speech communication address is transmitted from said terminal to said center by packet communication, and the relationship between the self-station packet communication address of the packet communication and the self-station speech communication address transmitted from said terminal is registered in said table (Figure 2 and column 4, lines 44 – 58).

Regarding claims 5 and 16, Chen in view of Toru, teach all the claimed limitations as recited in claim 1. Both Chen and Toru further teach of wherein a speech communication address of said center is designated by said center with respect to said terminal during execution of packet communication by said terminal (Chen: Figure 2 and column 4, lines 44 – 58; Toru: pages 5 and 6, paragraphs 0041 – 0044 of the “Detailed Description” translation packet), and a packet communication address of said terminal which has performed speech communication with said center is acquired by specifying said terminal from the terminated speech communication address (Chen: Figure 2 and column 4, lines 44 – 58; Toru: pages 5 and 6, paragraphs 0041 – 0044 of the “Detailed Description” translation packet).

Regarding claim 6, Chen in view of Toru, teach all the claimed limitations as recited in claim 1. Chen further teaches of wherein said center further comprises communication control means for switching speech communication by said speech control means and packet communication by said packet communication means (Figure 1 and column 3, lines 51 – 58 and column 4, lines 7 – 37).

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Regarding claim 7, Chen in view of Toru, teach all the claimed limitations as recited in claim 6. Chen further teaches of wherein said terminal comprises switch means for alternately switching speech communication and packet communication (column 5, lines 23 – 35), and said communication control means performs switching operation in accordance with an output from said switch means (column 5, lines 23 – 35).

Regarding claim 8, Chen in view of Toru, teach all the claimed limitations as recited in claim 6. Chen further teaches of wherein said communication control means automatically performs switching operation under sequence control (column 5, lines 22 – 35).

Regarding claim 9, Chen in view of Toru, teach all the claimed limitations as recited in claim 1. Chen further teaches of wherein said terminal comprises a microphone to which speech transmitted to said center is input (Figure 1 and column 3, lines 41 – 46 and column 4, lines 54 – 57), a speaker for outputting a speech signal transmitted from said center (Figure 1 and column 3, lines 41 – 46 and column 2, lines 46 – 49), a display screen on which character information transmitted from said center is displayed (Figure 1 and column 3, lines 41 – 46), and a key operation section for performing dial-input operation (Figure 1 and column 3, lines 41 – 46) and Toru further teaches of a display screen on which character/image information transmitted from said center is displayed (abstract and page 4, paragraph 0032 of the “Detailed Description” translation packet and Drawings 1 and 20 – 23).

Regarding claim 10, Chen in view of Toru teach all the claimed limitations as recited in claim 1. Chen further teaches of wherein said terminal comprises radio means for performing radio communication with a base station to which said center is connected (Figure 1 and starting column 3, line 53 and ending column 4, line 6), speech communication means for performing



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speech communication with said center (column 4, lines 7 – 37), packet communication means for performing packet communication with said center (column 6, lines 7 – 10 column 5, lines 27 – 35), and communication control means for switching speech communication by said speech communication means and packet communication by said packet communication means (column 5, lines 22 – 35).

Regarding claim 11, Chen teaches of a terminal of an information search system for searching for information by selectively performing speech communication and packet communication with a center (Figures 1 – 4), comprising: a microphone to which speech transmitted to the center by speech communication is input (Figure 1 and column 3, lines 41 – 46 and column 4, lines 54 – 57); a speaker for outputting a speech signal transmitted from the center by speech communication (Figure 1 and column 3, lines 41 – 46 and column 2, lines 46 – 49); a display screen on which character information transmitted from the center by packet communication is displayed (column 3, lines 39 – 50); and a key operation section for performing dial-input operation (Figure 1 and column 2, lines 24 – 29).

Chen does not specifically teach of a display screen on which at least one of image information and character information transmitted from the center by packet communication is displayed (though it should be noted that Chen does teach of a display in column 5, lines 14 – 16).

In a related art dealing with searching Internet databases using a mobile device, Toru teaches of a display screen on which at least one of image information and character information transmitted from the center by packet communication is displayed (abstract and page 4, paragraph 0032 of the “Detailed Description” translation packet and Drawings 1 and 20 – 23).

It would have been obvious to one skilled in the art at the time of invention to have included into Chen's mobile inquiry system, Toru's voice recognition system, for the purposes of speaking user commands to access information for viewing, as taught by Toru.

Regarding claim 12, Chen in view of Toru, teach all the claimed limitations as recited in claim 11. Chen further teaches of further comprising: radio means for performing radio communication with a base station to which the center is connected (Figure 1 and starting column 3, line 53 and ending column 4, line 6); speech communication means for inputting/outputting a speech signal between said speaker and said microphone by performing speech communication with said center (column 2, lines 29 – 38 and column 4, lines 54 – 58); communication control means for switching speech communication by said speech communication means and packet communication by said packet communication means (column 5, lines 23 – 35) and both Toru and Chen further teach of packet communication means for outputting at least one of image information and character information to said display screen by performing packet communication with the center (Toru: abstract and page 4, paragraph 0032 of the "Detailed Description" translation packet and Drawings 1 and 20 – 23; Chen: column 5, lines 14 – 35).

Regarding claim 13, A center of an information search system for searching for information by selectively performing speech communication and packet communication with a terminal (Figures 1 – 4), comprising: speech control means for performing speech communication with said terminal during execution of packet communication by said terminal (Figures 1 – 4 and column 2, lines 24 – 49), information search means for searching for information on the basis of the speech information recognized by said speech recognition means

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(column 4, lines 44 – 51), speech conversion means for converting the speech information of the information searched out by said information search means into a speech signal and outputting the signal to said speech control means (Figures 1 – 4 and column 2, lines 24 – 49), the speech signal from said speech conversion means being transmitted to said terminal by said speech control means (Figures 1 – 4 and column 2, lines 24 – 49).

Chen does not specifically state speech recognition means for recognizing a speech signal received by said speech control means and sent from said terminal and packet control means for transmitting at least one of image information and character information of the information searched by said information search means to said terminal by packet communication (though it should be noted that Chen does teach of and packet control means for transmitting character information of the information searched by said information search means to said terminal by packet communication in column 3, lines 39 – 50).

In a related art dealing with searching Internet databases using a mobile device, Toru teaches of speech recognition means for recognizing a speech signal received by said speech control means and sent from said terminal (abstract and page 4, paragraph 0032 of the “Detailed Description” translation packet and Drawings 1 and 20 – 23); and packet control means for transmitting at least one of image information and character information of the information searched by said information search means to said terminal by packet communication (abstract and page 4, paragraph 0032 of the “Detailed Description” translation packet and Drawings 1 and 20 – 23).

It would have been obvious to one skilled in the art at the time of invention to have included into Chen's mobile inquiry system, Toru's voice recognition system, for the purposes of speaking user commands to access information for viewing, as taught by Toru.

Regarding claim 17, Chen in view of Toru, teach all the claimed limitations as recited in claim 13. Chen further teaches of communication control means for switching speech communication by said speech control means and packet communication by said packet communication means in accordance with switching operation of the terminal (column 5, lines 23 – 35).

Regarding claim 18, Chen teaches of a center of an information search system for searching for information by performing speech communication and packet communication with a terminal (Figures 1 – 4) comprising: speech control means for performing speech communication with said terminal during execution of packet communication by said terminal (Figures 1 – 4 and column 2, lines 24 – 49), information search means for searching for information on the basis of the speech information recognized by said speech recognition means (column 4, lines 44 – 51) and packet control means for transmitting said information of the information searched by said information search means to said terminal by packet communication (column 3, lines 39 – 50)

Chen does not specifically state speech recognition means for recognizing a speech signal received by said speech control means and sent from the terminal.

In a related art dealing with searching Internet databases using a mobile device, Toru teaches of speech recognition means for recognizing a speech signal received by said speech

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control means and sent from said terminal (abstract and page 4, paragraph 0032 of the "Detailed Description" translation packet and Drawings 1 and 20 – 23).

It would have been obvious to one skilled in the art at the time of invention to have included into Chen's mobile inquiry system, Toru's voice recognition system, for the purposes of speaking user commands to access information for viewing, as taught by Toru.

***Citation of Pertinent Prior Art***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

| Inventor          | Publication | Number    | Disclosure   |
|-------------------|-------------|-----------|--|
| Wise et al.       | US Patent   | 5,884,262 | Computer Network Audio Access and Conversion System                        |
| Imielinski et al. | US Patent   | 6,240,448 | Method and System for Audio Access to Information in a Wide Area Network   |
| Kari et al.       | US Patent   | 6,542,489 | Method and Means for Transmitting a Service Page in a Communication System |

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanmay S Lele whose telephone number is (703) 305-3462. The examiner can normally be reached on 9 - 6:30 PM Monday - Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A. Maung can be reached on (703) 308-7745. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

  
Tanmay S Lele  
Examiner  
Art Unit 2684

tsl  
February 18, 2004

  
**NAY MAUNG**  
**SUPERVISORY PATENT EXAMINER**